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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/715,839      | 11/19/2003  | Alain Lagrange       | 06028.0032-00       | 3618             |

22852 7590 03/23/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

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| EXAMINER |
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ELHILO, EISA B

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1751

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/715,839             | LAGRANGE ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Eisa B. Elhilo         | 1751                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-76 is/are pending in the application.
- 4a) Of the above claim(s) 27-44, 46 and 47 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-26, 45, 48-54 and 69-76 is/are allowed.
- 6) ☒ Claim(s) 55-57, 59, 66 and 67 is/are rejected.
- 7) ☒ Claim(s) 58, 60-65 and 68 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/29/04 &amp; 3/2/06</u> .                                                | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1 This action is responsive to the applicant's election received by the office on March 2,  
2006.

2 Applicant's election with traverse to prosecute the species of azo compounds, which are  
compounds of formulae (XXIII) to (XXVIII). Election of claims 20-26, 45 and 48-76 is  
acknowledged. Claims 27-44 and 46-47 are withdrawn from further consideration by the  
examiner, 37 CFR 1.142(b), as being drawn to a non-elected species. Therefore, claims 20-26, 45  
and 48-76 are pending in this application.

3 The traversal is on the ground(s) that the Examiner has failed to show that a serious  
burden exists to examine all of the alleged species. This is not found persuasive because the  
species formulae are patentably independent and distinct and they are classified and searched in  
different classes and subclasses and the search required for each group is not required for the  
other groups of the species. Therefore, restriction for examination purposes as indicated is  
proper. The requirement is still deemed proper and is therefore made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected species, the  
inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the  
currently named inventors is no longer an inventor of at least one claim remaining in the  
application. Any amendment of inventorship must be accompanied by a request under 37 CFR  
1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

4 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 55-57, 59 and 66-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Leugs et al. (US 6,160,037).

Leugs et al. (US' 037) teaches a composition comprising a pigment and alcohols of amino-methyl-propanol and ethyleneglycol as claimed in claim 55 (see col. 30, Example II), wherein the pigment has a formula (I) (see col. 2, formula (I)), which is identical to the claimed formula (I), when in the reference's formula (I), A is a dye (chromophoric) radical chosen from azo dye of a formulae (XVIIIa, XVIIIb, XVIIIc and XVIIIc (see cols. 13-14, the formulae), X is an integer from 1 to 8 and B is a group of a formula (IV) in which  $s = t = 0$  and W is hydrogen (cationic radical) as claimed in claims 56-57 and 59, (see col. 2, lines 33-67 and col. 3, lines 36-50) and when in the claimed formula (I), A is dye chosen from azo radical, X is an integer ranging from 1 to 8, m and  $m' = 0$ ,  $n = 1$ , Y = oxygen atom and Z is a hydrogen, and wherein monoalcohol or polyols are presented in the amounts of 0.5 % and 2% which within the claimed ranges as claimed in claim 66 (see col. 30, Example II) and wherein the pigment compound is presented in the composition in the amount of 0.1 to 20% as claimed in claim 67 (see 24, lines 27). Leugs et al. (US' 037) teaches all the limitations of the instant claims. Hence, Leugs et al. (US' 037) anticipates the claims.

***Allowable Subject Matter***

5        Claims 58, 60-65 and 68 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

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claim and any intervening claims. The prior art of record do not teach or disclose the limitations of the claims.

6 Claims 20-26, 45, 48-54 and 69-76 are allowed because the prior art of record do not teach or disclose a method for dyeing hair comprising the claimed steps. Also the prior art of record do not teach or disclose the claimed kit limitations.

### ***Conclusion***

The references listed on from PTO-1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

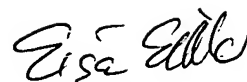
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Eisa Elhilo". The signature is written in a cursive, flowing style.

Eisa Elhilo  
Primary Examiner  
Art Unit 1751

March 16, 2006